

### **REMARKS**

The Office Action dated May 19, 2006 has been received and carefully noted. The above amendments to claims 1, 11, 14, 17-20, and 23, new claims 31-33, and the following remarks, are submitted as a full and complete response thereto. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-33 are pending and under consideration.

### **ELECTION/RESTRICTION:**

In the Office Action, at page 2, claims 17-19 were withdrawn from consideration by the examiner as being directed to a non-elected invention. In response, independent claim 17 and related dependent claims 18 and 19 have been amended, each to be a dependent claim and to depend on claim 14. Accordingly, because the subject matter recited in claims 17-19 further define the apparatus recited in claim 14, the patentability of which has already been considered by the examiner, it is respectfully requested that claims 17-19 be considered.

Accordingly, it is respectfully requested that the objection to the claim be withdrawn.

### **REJECTION UNDER 35 U.S.C. § 102:**

In the Office Action, at page 4, claims 1-4, 11, and 14 were rejected under 35 U.S.C. § 102 as being anticipated by U. S. Patent No. 6,275,690 to Higuchi et al. ("Higuchi"). The Office Action took the position that Higuchi describes all the

recitations of independent claims 1, 11, and 14 and related dependent claims. Particularly, the Office Action focused on the description provided in column 6, lines 4-13 and 19-37 of Higuchi as describing the recitations of independent claims 1, 11, and 14. It is respectfully asserted that, for at least the reasons provided herein below, Higuchi fails to teach or suggest the recitations of the pending claims. Reconsideration is requested.

Independent claim 1, upon which claims 2-10 and 24-26 are dependent, recites a method for processing a voice call establishment request from a calling terminal to a called terminal. The method includes detecting the call establishment request, in response to said detecting, alerting the called terminal, and, in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal. The method further includes determining that a two-way voice call between the calling terminal and the called terminal is not allowed, receiving silent messages via the called terminal and/or the calling terminal, and conveying information based on said silent messages to the calling terminal and/or the called terminal, respectively.

Independent claim 11, upon which claims 12-13 are dependent, recites an apparatus for processing a voice call establishment request from a calling terminal to a called terminal. The apparatus includes means for detecting the call establishment request, means for setting up, in response to said alerting, a two-way connection between the calling terminal and the called terminal, means for determining that a two-way voice call between the calling terminal and the called terminal is not allowed, means for

receiving silent messages via the called terminal, and means for conveying information based on said silent messages to the calling terminal.

Independent claim 14, upon which claims 15-16 and 17-19 are dependent, recites an apparatus for processing a voice call establishment request from a calling terminal to a called terminal. The apparatus is configured to detect the call establishment request, in response to said detection, set up a two-way connection between the calling terminal and the called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, receive silent messages via the called terminal, and convey information based on said silent messages to the calling terminal.

As will be discussed below, Higuchi fails to disclose or suggest the elements of any of the presently pending claims.

One of the many aspects of the present invention is to provide an apparatus and method to allow at least one of the parties participating in a two-way communication to participate silently, if needed. The need to establish a silent call, in at least one direction, may be developed during the call. See specification, page 2, lines 15-31. For instance, one of the parties may be in a movie, and it may be possible to speak before the movie starts, but when it starts, the call must be continued silently, if at all. Thus, the present invention allows an existing call to be continued without major interruptions and allows for at least one of the parties to continue the call in a silent mode, that is, a call mode in which the party in question does not speak. For instance, if a B party is in a library, the B party can have a call in which the incoming half-call is a conventional voice call but the outgoing half-call is a silent one. On the other hand, a hearing impaired person may

participate in a call in which the incoming half-call is silent but the outgoing one is a conventional voice call, assuming that the hearing-impaired person is able to speak.

Accordingly, in accordance with an embodiment of the present invention and as recited in independent claim 1, a method is provided which comprises: 1) detecting the call establishment request, 2) in response to said detecting, alerting the called terminal, 3) in response to said alerting, setting up a two-way communication between the calling terminal and the called terminal. Thus, according to the present invention, after the establishment request and the call alert the two-way connection is actually set up.

In contrast, Higuchi generally describes a solution in which the control circuit monitors whether or not the user manipulates a key on the cellular mobile telephone apparatus in response to the incoming call notification or whether or not a state-holding key has been previously depressed. If the user does not respond to the incoming call notification in spite of the incoming call notification which has been provided to the user for the predetermined time period, the control circuit transmits an absence message for notifying the calling party that the user is now absent, and initiates a recording operation when the calling party wants to leave some message. (col. 6, lines 10-25 of Higuchi). However, merely transmitting an absence message is not an establishment of a two-way communication. It is not possible for a person of ordinary skill in the art to construe the transmission of an incoming call notification from the calling party to a called party and the transmission of an absence message from the called party to the calling party as a two-way communication. Instead, the transmission of the absence message is a non-responsive indication of a voice call ban. After the transmission of the incoming call

notification, there is no teaching or suggestion in Higuchi that a two-way communication is established. Instead, a voice call ban or absence message is given **before** a set-up of a two-way connection.

Similarly to a cellular telephone that is out of range and unable to receive calls, the network serving the cellular telephone may be set up to transmit a message to a calling telephone that the cellular telephone is out of range or unavailable. However, such transmission of such message cannot be construed as a two-way communication between the cellular telephone and the calling telephone.

In contrast, according to the present invention, **after** the establishment request and the call alert, the two-way communication is set up. That is, as recited, in part, in independent claim 1, “in response to said detecting, alerting the called terminal,” and “in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal.”

Furthermore, in Higuchi, if the user responds by manipulating a key while the reception of the incoming call is being notified to the user or if one of the state holding keys has been previously depressed, an operation specified by an associated key is performed. Keys used at the reception of an incoming call are classified into two: function keys, according to the present invention, and a pending key within a key input device. Because three function keys are provided, up to three kinds of messages may be registered. For example, a message “Since I am now driving a car, I will call you later when I stop the car” maybe registered in a function key 1; a message “Since I am now in a cabin of a train, please hold on for a while until I go to the deck” may be registered in a

function key 2; and a message "Since I am now in conference, please call me again in about one hour" may be registered in a function key 3. (col. 6, line 4 -col. 7, line 10 of Higuchi).

Thus, according to Higuchi, the voice call ban is given before a set-up of a two-way connection between the terminals. In other words, Higuchi prevents the two-way connection to be set up at all. Higuchi does not teach or suggest, at least, "in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal," and "determining that a two-way voice call between the calling terminal and the called terminal is not allowed," as recited in independent claim 1.

Because independent claims 11 and 14 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11 and 14, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11 and 14.

Accordingly, in view of the foregoing, it is respectfully requested that independent claims 1, 11, and 14 and related dependent claims be allowed.

In the Office Action, at page 5, claims 1-13, 14, 15, and 16 were rejected under 35 U.S.C. § 102 as being anticipated by U. S. Patent No. 6,185,433 to Lele et al. ("Lele"). The Office Action took the position that Lele describes all the recitations of independent claims 1, 11, and 14 and related dependent claims. Particularly, the Office Action focused on the description provided in column 8, lines 51-64, of Lele as describing the

claimed recitations of independent claims 1, 11, and 14. It is respectfully asserted that, for at least the reasons provided herein below, Lele fails to teach or suggest the recitations of the pending claims. Reconsideration is requested.

As will be discussed below, Lele fails to disclose or suggest the elements of any of the presently pending claims.

Lele generally describes a solution in which when the called device is in the busy operational mode the infrastructure receives a data message from the called device indicating that the called device is in the busy operational mode. The infrastructure then transmits an acknowledgement of receipt of the data message to the called device. (col. 8, lines 51-64 of Lele)

However, according to Lele, the data message is given **before** a set-up of a two-way connection between the terminals. In other words, Lele prevents the two-way connection to be set up at all. Lele does not teach or suggest, at least, “in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal,” and “determining that a two-way voice call between the calling terminal and the called terminal is not allowed,” as recited in independent claim 1.

Simply transmitting a data message indicative of a busy operational mode is not an establishment of a two-way communication. On the contrary, the busy operational mode is indicative that a two-way communication cannot be established. It is not possible for a person of ordinary skill in the art to construe the transmission of an incoming call notification from the calling party to a called party and the transmission of an absence message from the called party to the calling party as a two-way communication. Instead,

the transmission of the data message is a non-responsive indication of a busy operational mode. After the transmission of the data message, there is no teaching or suggestion in Lele that a two-way communication is established. Instead, a data message and an acknowledgement of receipt are given **before** a set-up of a two-way connection.

Because independent claims 11 and 14 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11 and 14, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11 and 14.

Accordingly, in view of the foregoing, it is respectfully requested that independent claims 1, 11, and 14 and related dependent claims be allowed.

In the Office Action, at page 7, claims 1, 2, 4-6, 89-12, 14, 15, 20-21, and 23 were rejected under 35 U.S.C. § 102 as being anticipated by U. S. Patent No. 6,741,678 to Cannell et al. ("Cannell"). The Office Action took the position that Cannell describes all the recitations of independent claims 1, 11, 14, 20, and 23 and related dependent claims. Particularly, the Office Action focused in FIG. 2 of Cannell as describing the claimed recitations of independent claims 1, 11, 14, 20, and 23. It is respectfully asserted that, for at least the reasons provided herein below, Cannell fails to teach or suggest the recitations of the pending claims. Reconsideration is requested.

Independent claim 20, upon which claims 21-22 are dependent, recites a mode user interface in a called terminal and/or a calling terminal. The user interface is



configured to select a desired call mode. In response to said selection, the user interface sets up a two-way connection between the calling terminal and the called terminal, and if a two-way voice call between the called terminal and the calling terminal is not allowed, receive silent messages from the calling terminal and/or the called terminal.

Independent claim 23 recites a mode communication system. The system is configured to detect a voice call establishment request from a calling terminal to a called terminal, in response to said detecting, alert the called terminal, in response to said alert, set up a two-way connection between the calling terminal and the called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, and receive silent messages via said called terminal and/or calling terminal and convey information based on said silent messages to the calling terminal and/or called terminal, respectively.

As will be discussed below, Cannell fails to disclose or suggest the elements of any of the presently pending claims.

Cannell generally describes a method for a called phone to communicate with a calling party without answering a call request from the calling party. The called party and the calling party may, thus, transmit data responses to each other. If the calling party is not data-capable, the solution allows converting the data response into a voice message to the calling party (col. 1, lines 34-51 of Cannell)

At step 201 of FIG. 2 of Cannell, a call requested is transmitted from a calling phone to a called phone. At step 203, the called phone receives the call request. At step 205, it is determined if the called phone answers the call request. If the called phone does

answer the call request, the call request is completed (206) and a call between the calling phone and the called phone is established. However, if the called phone does not answer the call request, the called phone determines (207) if the called phone wishes to send a data message to the calling phone. If not, the call request will not be completed and the process ends. If the called phone wishes to send a data message to the calling phone, the system determines (209) if the calling phone is data capable. If so, the called phone sends (210) a data message to the phone and then the process ends.

Cannell clearly sets forth that a two-way communication is not set-up. Specifically, Cannel does not teach or suggest that “in response to a detection of a call establishment request, “alerting the called terminal,” and “in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal,” as recited in independent claim 1. Cannell only detects that a call request is received. Instead of then setting up a two-way connection between the calling phone and the called phone, Cannell determines whether the called phone wishes to send a data message to the calling phone. Thus, Cannell does not teach or suggest all the recitations of independent claim 1.

Because independent claims 11, 14, 20, and 23 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 14, 20, and 23, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 14, 20, and 23.

Accordingly, in view of the foregoing, it is respectfully requested that independent claims 1, 11, 14, 20, and 23 and related dependent claims be allowed.

**REJECTION UNDER 35 U.S.C. § 103:**

In the Office Action, at page 9, claims 3, 22, 24-27, 28, and 29 were rejected under 35 U.S.C. § 103 as being unpatentable over Cannell in view of U.S. Patent No. 7,010,288 to Brown et al. ("Brown"). The Office Action took the position that Cannell and Brown disclose all the aspects of dependent claims 3, 22, 24-27, 28, and 29. The rejection is traversed and reconsideration is requested.

As will be discussed below, Cannell and Brown fail to disclose or suggest the elements of any of the presently pending claims.

Dependent claims 3, 24-26 depend from independent claim 1, dependent claims 22 and 29 depend from independent claim 20, dependent claim 27 depends from independent claim 11, and dependent claim 28 depends from independent claim 14. Because the combination of Cannell and Brown must teach, individually or combined, all the recitations of the base claim and any intervening claims of dependent claims 3, 22, 24-27, 28, and 29, the arguments presented above supporting the patentability of independent claims 1, 11, 14, and 20 over Cannell are incorporated herein.

**Brown generally describes a method for providing an automatic data response to a calling party when a called party is unable to participate in a voice call. (col. 2, lines 43-47; abstract). However, Brown does not cure the deficiencies of Cannell. Similarly to Cannell, Brown does not teach or suggest, "in response to said**

**detecting, alerting the called terminal,” and “in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal,” as recited in independent claim 1. A combination of Cannell and Brown would fail to teach that a two-way connection is set-up after alerting a called terminal.**

Furthermore, Applicants respectfully submit that the Office Action has pieced together two references to teach the claimed invention. Without providing any evidentiary support in either Cannell or Brown, the Office Action conclusively contends that “it would therefore have been obvious to one of ordinary skill in the art to provide for incoming call auto-response based on predetermined user profile in order to avoid users having to constantly change their outgoing or response messages to incoming calls.” However, Cannell does not teach or suggest any need to provide such motivation to include the description provided in Brown as contended in the Office Action. MPEP 2143.01 instructs that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990).” MPEP 2143.01 further instructs that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” Applicants respectfully submit that the cited references do not provide such a suggestion or motivation. Applicants submit that the only motivation to piece together Cannell and Brown of the Office Action is found in Applicants’ own application. MPEP 2141, under the heading “Basic Consideration Which Apply to Obviousness Rejections,” points out that “the references

must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” (See also *Hodosh v. Block Drug Co. Inc.*, 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986)). The Federal Circuit has clearly held that “the motivation to combine references cannot come from the invention itself.” See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc.*, 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

In view of MPEP 2144.03, absent any teaching or suggestion in Cannell to adapt the description of Brown to meet the claimed invention, and because the rejection lacks evidence of a teaching or suggestion that the features would have been obvious to one of ordinary skill, the rejection under 35 U.S.C. §103(a) is improper. Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. §103(a) should be withdrawn.

Because independent claims 1, 11, 14, and 20 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 1, 11, 14, and 20, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 1, 11, 14, and 20.

Accordingly, in view of the foregoing, it is respectfully requested that independent claims 1, 11, 14, and 20 and related dependent claims 3, 22, 24-27, 28, and 29 be allowed.

**CONCLUSION:**

In view of the above, Applicant respectfully submits that the claimed invention recites subject matter which is neither disclosed nor suggested in the cited prior art. Applicant further submits that the subject matter is more than sufficient to render the claimed invention unobvious to a person of skill in the art. Applicant therefore respectfully requests that each of claims 1-33 be found allowable and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the Applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension together with any additional fees may be charged  
to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Alicia M. Choi', written over a horizontal line.

Alicia M. Choi  
Registration No. 46,621

Customer No. 32294  
SQUIRE, SANDERS & DEMPSEY LLP  
14<sup>TH</sup> Floor  
8000 Towers Crescent Drive  
Tysons Corner, Virginia 22182-2700  
Telephone: 703-720-7800  
Fax: 703-720-7802

AMC:jkm:kmp

Enclosures: Additional Claim Fee Transmittal  
Check No. 14916